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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,255	05/04/2005	Luc Moens	2005_0521A	4476
513 7590 05/16/2008 WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021				
EXAMINER TOSCANO, ALICIA				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/529,255

**Applicant(s)**

MOENS ET AL.

**Examiner**

Alicia M. Toscano

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 17-21 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-14 and 17-21 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☒ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/5508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. As set forth in the action dated 9/21/07, Claim 10 is objected to because of the following informalities: 0.1 should have a period, not comma, separating the numbers. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1, 2, 4-14 and 17-21 are rejected under 35 U.S.C. 103(a) as obvious over Shoji (JP 57-205458) in view of Daly (US 6294610).

This rejection is as set forth in the action dated 9/21/07. Regarding new claims 18-21, since the compositional elements are met by Shoji and Daly the gloss and curability of the powder coating are deemed inherent. The Examiner notes that the only reference in Shoji as to the gloss is in Table 1, wherein Applicant's submitted English translation refers to a "luster" of around 85, and wherein the USPTO translated document refers to "shine" of around 85. There is no ASTM derived data for Shoji, nor a disclosure as to what range of gloss values are obtainable or desirable in the composition of Shoji. See further remarks below.

3. Claims 1-14 and 17-21 are rejected under 35 U.S.C. 103(a) as obvious over Shoji (JP 57-205458) and Daly (US 6294610) in view of Pettit (5202382).

This rejection is as set forth in the action dated 9/21/07. Regarding new claims 18-21, since the compositional elements are met by Shoji and Daly the gloss and curability of the powder coating are deemed inherent. The Examiner notes that the only reference in Shoji as to the gloss is in Table 1, wherein Applicant's submitted English translation refers to a "luster" of around 85, and wherein the USPTO translated document refers to "shine" of around 85. There is no ASTM derived data for Shoji, nor a disclosure as to what range of gloss values are obtainable or desirable in the composition of Shoji. See further remarks below.

### ***Conclusion***

#### ***Response to Arguments***

1. Applicant's arguments filed 3/19/08 have been fully considered but they are not persuasive. Applicant argues Shoji's deficiencies are as set forth by Applicant's specification pg 3 lines 6-7, ie, that Shoji intends to produce smooth, high gloss finishes at high curing temperatures. Applicant argues that merely because Shoji and Daly are in the same general field of powder coatings does not yield a proper prima facie case of obviousness, as had been set forth in the last response. Applicant argues one must consider the document as a whole and when looking at each document as a whole there is no reason to combine Shoji with Daly. Applicant argues vague assertions about a generic suitability for intended use are insufficient to rebut Applicant's arguments of

record. Applicant argues there must be a credible motive for a skilled artisan to select any particular element over another. Applicant argues amorphous and semicrystalline polymers are not recognized in the art as functional equivalents, as evidenced by WO 91/014745 and WO 04-083325, which exploit the different properties of said polymers for powder coatings. Applicant argues that though the compositional elements are met the other physio chemical properties would not be met, that one can not assume it would be obvious to simply exchange catalysts between all powder coatings, clear and pigmented coatings are not necessarily functional equivalents and that cure times and methods of applications may need to be adapted for the coatings of interest. Applicant further goes on in pages 9-13 to state that the rejection fails to provide any reason why a skilled person wishing to prepare powder coatings would refer to Shoji, that the skilled reader would be unaware of the problem at hand, and asks "what is the motivation in Shoji to specifically refer to Daly rather than any other reference in the field". Applicant further goes on to argue that if someone started with Daly one would not arrive at the present invention. Regarding the combination with Pettit Applicant argues one seeking to produce low gloss would not look to Pettit who teaches high gloss and goes on to argue that one would not be motivated to start with Shoji, Daly and Pettit to solve the problem at hand.

2. The Examiner disagrees. Firstly, Applicant persists in the issue that one looking to make a low gloss powder coating would not start or end or look to the references at hand however the low gloss requirements are in dependant, and newly added, claims 18 and 20. Thusly, arguments drawn to such are not given much weight since all the

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claims are not required to have low gloss properties. Even as such it is unclear to the Examiner why, when the compositional elements are met, said gloss would not be inherent. The only disclosure that Shoji intends to produce only high gloss coatings comes from Applicant's disclosure, which is not proper. The Examiner was unable to find in either of the translations of Shoji a teaching that Shoji was drawn solely to high gloss products. Since the compositional elements are met it is unclear to the Examiner why the gloss coatings of Shoji v. Daly (or Shoji, Daly and Pettit) would be different from Applicant's. Further, since the compositions are so similar the Examiner requests evidence as to how one of ordinary skill in enabled to make Applicant's desired (but not required in all the claims) low gloss coating. If there are particular elements distinctly required to make the coating low gloss versus high gloss (which seems to be the case since the compositions greatly overlap), the Applicant should show, and claim, said elements.

3. Regarding the motivation to combine, said motivation to combine is proper, as previously set forth. It is unclear to the Examiner why, when Shoji and Daly disclose such similar compositions, that one looking to make the composition of Shoji would not look to the prior art for a similar composition for a teaching of the Tg. That Daly is drawn to a different end result, a different cure time, a different gloss is moot. The Tg has not been shown by Applicant or Daly to affect said properties. Daly teaches that said Tg is suitable for powder coatings. If Applicant is asserting that the Tg is the sole driver of gloss, cure times and other various properties, the Examiner reminds Applicant that a showing of unexpected results derived from using the Tg of Daly would overcome

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the rejection. Applicant has asserted that the Examiners previous remarks were vague or unaddressed and did not properly put forth motivation to combine. It is unclear to the Examiner what remarks, comments and/or arguments were not addressed by the Examiner and the Examiner requests clarification so that said remarks, comments and/or arguments can be addressed and/or clarified. The motivation set forth by the Examiner is credible, see the Sinclair and Carroll case law as put forth in the previous action. It is unclear why said case is not deemed credible to Applicant and the Examiner requests clarification. Regarding the functional equivalence of amorphous and semi-crystalline polymers, Applicant has shown evidence that said polymers have different properties. Said results are not unexpected. That the prior art has exploited said properties for their use is not convincing. A showing of unexpected results in the context of Applicant's invention is required. Likewise, Applicant merely argues that pigments, cure times and catalysts can not be exchanged, however no evidence is provided. Applicant is invited to show unexpected results stemming from the interchange of said elements. Applicant's arguments stemming pages 9-13 are found moot. The motivation to combine Shoji and Daly is proper for the reasons set forth above. It is the Examiner's position that one looking at Shoji would not be deterred by the teachings of Daly. The Tg's of Daly are taught to be suitable for use in the powder coating industry. The polymers of Shoji are very similar and overlap that of Daly. That the references may be drawn to different end products, cure times or properties is not persuasive since the Tg is not taught to directly affect said properties. One would be motivated to use Daly instead of any of the other plethora of powder coating teachings

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of the prior art since the compositions of Shoji and Daly are so similar. Regarding Pettit, Pettit does not teach away from Shoji or Daly. Pettit teaches motivation as to why one would want two different Tg's. Though Pettit is drawn to higher gloss coatings, Shoji does not limit the gloss of his invention to low or high gloss coatings. Thusly, Pettit in no way teaches away from the desires or end products of Shoji. Also, there is no evidence that the low gloss would not be inherent when combining Shoji and Pettit since the compositional elements are met. Questions posed by Applicant as to why one would look to Pettit to form low gloss coating are moot since (1) Applicant's claims are not drawn to only low gloss coatings and (2) Shoji does not limit his invention to only high gloss products. Applicants arguments asking why one would start with Shoji, Pettit or Daly are moot. Shoji discloses the claimed invention but does not disclose the Tg of the polymers. Daly and Pettit both teach reasons why one would want the to use the Tg's taught therein (ie, since they are known to be suitable for powder coatings and because a blend of high and low Tg is taught to give improved properties). The motivation is proper and stands.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within



TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Toscano whose telephone number is (571)272-2451. The examiner can normally be reached on M-F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AMT

/Randy Gulakowski/  
Supervisory Patent Examiner, Art Unit 1796